search circuit that locates the at least one object to be annotated and provides an object

identifier that corresponds to the at least one object the annotation device allowing a user to

make at least one annotation independently from the at least one object, the annotation device

comprising an input device that inputs the at least one annotation, an annotation linking

circuit that establishes a link associating the at least one annotation with at least one portion

of the object, a database that stores the object identifier, the at least one annotation and the

link, and a synchronize circuit that associates the at least one annotation with the at least one

portion of the object based on the link and the object identifier, and wherein the user makes

annotation using the annotation device while viewing the at least one object using the distinct

viewing device, and upon synchronization by the synchronize circuit, the at least one

annotation is transferred to the at least one object, as recited in claim 1. These reasons apply

by extension to claims 1-13 based on their dependence from claim 1.

Moreover, Eberman and Schilit fail to teach or suggest a method for associating

annotations with at least one object comprising searching for the at least one object to

annotate, obtaining an object identifier for the at least one object, generating at least one

annotation using an annotation device and an input device that is distinct from the annotation

device, while displaying the at least one object with a viewing device that is distinct from the

annotation device, establishing a link associating the at least one annotation with the object,

transferring the at least one annotation to the at least one object by associating the at least one

annotation with the at least one object based on the link and the at least one object identifier,

as recited in claim 14, and similarly recited for an information storage media recited in claim

26. These reasons apply by extension to claims 15-25 based on their dependence from claim

14 and claims 27-37 based on their dependence from claim 26.

For example, the specification discloses various exemplary aspects of an annotation

device (100) in Fig. 1 that includes an input/output interface (130), an annotation/link

database (140), an annotation linking circuit (150), a synchronize circuit (160) for associating annotations with an object identification and a search circuit (190). The annotation device (100) is connected via a synchronization link (25) to an internet protocol device (10) and a display device (20), as well as to a network (320) that connects to a document storage database (300), an annotation database (310) and to media-type objects (210). As described in the specification and recited in the claims, the annotation device (100) and the display device (20) are separate physical entities. The specification further describes method steps in Figs. 9A-9B that include procedures for performing a search of an object (step S110), retrieving, forwarding and receiving an object identification (steps S130, S160 and S170, respectively), annotating the object (step S260), associating the annotations with the object identification (step S270). The method is further described in Figs. 10-12 for object annotation (step S270) that includes searching the object for a text portion to be annotated (step S1020), establishing the object identifier with a portion location (step S1040) and establishing the identifier associated with the portion location (step S2030).

A *prima facie* case of obviousness for a §103 rejection requires satisfaction of three basic criteria: there must be some suggestion or motivation either in the references or knowledge generally available to modify the references or combine reference teachings, a reasonable expectation of success, and the references must teach or suggest all the claim limitations. See MPEP §706.02(j). Applicants respectfully submit that the Final Office Action fails to satisfy these criteria based on Eberman and Schilit.

Eberman discloses a system 10A for ranking multimedia annotations. In particular, Eberman teaches the system 10A having annotation clients 18 connected to a network 34 that interacts with audiovisual data 12 through encoder clients 14, a media database 22 through a server 24 and a meta database 26 through a librarian 28. An object database 120 of the meta database 26 includes objects 122, representations 124 of a respective object, and annotations

126 of the object. The annotation client 18 requests a copy of the data 12 from the librarian

28 to generate annotations for an object in the meta database 26 and associated with an

identification number. Eberman teaches that the annotations are a collection of values in an

annotation structure 110, with time marks 117 and arcs 118 associated with value

probabilities for ranking purposes. See col. 4, lines 44-57; col. 7, line 19 – col. 8, line 17; col.

15, lines 12-23, 46 – col. 16, line 10 and Figs. 1A and 7 of Eberman.

As admitted by the Final Office Action at paragraph 3(b) on pp. 3-4 and agreed to

during the January 12, 2005 personal interview with Dr. Spong, Eberman fails to disclose "a

viewing device that is distinct from the annotation device." The Final Office Action asserts

that Schilit compensates for this deficiency by disclosing distinct viewing and annotation

devices, referring to page 1, Fig. 1 of Schilit. Applicants respectfully disagree.

Schilit discloses an active reading machine based on XLibris. In particular, Schilit

teaches a tablet computer that combines a flat-panel display to image the document to be

annotated and a "digital ink" stylus with which to make annotation marks using XLibris

software. The tablet platform can be provided by a Mutoh display. XLibris is implemented

in C++ and executed on Windows 95/NT, without using Microsoft widgets. The stylus serves

as a "pen" by simulating ink strokes while capable of "dwell" menu selection from pressing

the pen at a stationary position. See pages 252, 255 and Figs. 1 and 2 of Schilit. Because

Schilit explicitly teaches that the display and annotation of the document are performed

concurrently on the tablet, Applicants assert that the interpretation of the Final Office Action

for Schilit teaching distinct devices for these functions is clearly erroneous.

Moreover, Schilit enables a user to make annotations directly on the tablet that

displays the document, the XLibris device of Schilit is not intended for and apparently cannot

incorporate, the object database 120 of Eberman that represents each object 122 by object

identifiers 124 and associates the object 122 with annotations 126 across the network 34

between the meta database 26 and the annotation client 18. Thus, there would have been no motivation to combine features related to the annotation ranking of Eberman with the XLibris tablet of Shilit because Schilit teaches away from the claimed features. Accordingly, one of ordinary skill would not have been motivated to combine Schilit with Eberman.

Applicants assert that the Examiner's allegation that it would have been obvious to one of ordinary skill in the art to implement combination of Eberman and Schilit in the Final Office Action at paragraph 4(b) on page 9 is merely a conclusory statement, and that no support for such a statement has been provided. When relying on what is asserted to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record.

The Final Office Action refers to page 255, left column, last paragraph of Schilit for support. Applicants point out that this portion provides only that "most previous attempts to improve reading with computation have focused on creating new media ... that redefine the documents being read, as well as the act of reading, placing them in a separate world from existing books and paper documents. This contrasts with our approach of supporting paper practices and paper-based documents." Contrary to the Final Office Action assertions, this statement by Schilit teaches away from use of multimedia networked document retrieval and annotation as provided in Eberman. Thus, the Final Office Action conclusions are unsupported by the teachings of the applied references.

Accordingly, the Final Office Action has not established a proper motivation to combine Schilit and Eberman for a *prima facie* case of obviousness. Applicants therefore respectfully submit that the rejection of claims 1-37 under 35 U.S.C. §103(a) is improper and should be withdrawn.

For at least these reasons, Applicants respectfully assert that independent claims 1, 4 and 26 are patentable over the applied references. The dependent claims are likewise

patentable over the applied references for at least the reasons discussed as well as for the

additional features they recite. Thus, Applicants respectfully request that the rejection under

35 U.S.C. §103 be withdrawn.

In view of the foregoing remarks, Applicants respectfully submit that this application

is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly

solicited.

Should the Examiner believe that anything further is desirable in order to place this

application in even better condition for allowance, the Examiner is invited to contact

Applicants' undersigned representative at the telephone number listed below.

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